

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Andrew T. Wilson
Serial No.: 10/684,167
Filed: October 10, 2003
Examiner: Jeffrey Donels
Group Art Unit: 2832
Confirmation No.: 2311
Title: PORTABLE HAND-HELD SYNTHESIZER AND NETWORKING
METHOD AND APPARATUS
Date: December 28, 2009

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Applicant respectfully requests that the Notice of Abandonment, mailed November 24, 2009, be withdrawn on the basis that the Applicant timely filed a Request for Rehearing under 37 CFR 41.52 on November 23, 2009.

Background

A Decision on Appeal before the BPAI was mailed September 22, 2009 affirming the Examiner's final rejection of Claims 1 and 3-30. *See* page 1 of Decision on Appeal (attached as Exhibit A). According to 37 CFR 41.52(a)(1), appellant may file a request for rehearing within two months of the date of the original decision of the board. Applicant (Appellant) filed a Request for Rehearing under 37 CFR 41.52 on November 23, 2009. *See* Electronic Acknowledgement Receipt (attached as Exhibit B) and Request for Rehearing (attached as Exhibit C).

According to 37 CFR 1.7(a), when the day for taking action falls on Sunday, the action may be taken on the next succeeding business day. Since the two-month date for responding to the Decision on Appeal fell on Sunday, November 22, 2009, the Request for Rehearing was timely filed on Monday, November 23, 2009 and the holding of abandonment should be withdrawn.

Respectfully submitted,

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/Joseph S. Makuch/

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW T. WILSON

Appeal 2009-003616¹
Application 10/684,167
Technology Center 2800

Decided: September 22, 2009

Before JOHN C. MARTIN, JOSEPH F. RUGGIERO, and
ROBERT E. NAPPI, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Intel Corporation. Br. 1.

Electronic Acknowledgement Receipt

EFS ID:	6511463
Application Number:	10684167
International Application Number:	
Confirmation Number:	2311
Title of Invention:	Portable hand-held music synthesizer and networking method and apparatus
First Named Inventor/Applicant Name:	Andrew T. Wilson
Customer Number:	32231
Filer:	Joseph S. Makuch/Lisa Riley
Filer Authorized By:	Joseph S. Makuch
Attorney Docket Number:	5038-293
Receipt Date:	23-NOV-2009
Filing Date:	10-OCT-2003
Time Stamp:	19:08:22
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Request for Rehearing of BPAI Decision	P12515X_Request_for_Rehearing_11_22_09.pdf	<div style="text-align: center;">16381</div> <div style="font-size: small;">264274c1b792a3578d5f445846210342650735879</div>	no	4

Warnings:

Information:

EXH
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Andrew T. Wilson
Serial No.: 10/684,167
Examiner: Jeffrey Donels
Filed: October 10, 2003
Group Art Unit: 2837
For: PORTABLE HAND-HELD MUSIC SYNTHESIZER AND
NETWORKING METHOD AND APPARATUS
Confirmation No.: 2311
Date: November 22, 2009
Mail Stop Appeal Briefs-Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING UNDER 37 CFR 41.52

This Request for Rehearing is responsive to the Decision on Appeal (hereinafter, the “Decision”) from the Board of Patent Appeals and Interferences (hereinafter, the “Board”) mailed September 22, 2009.

The Factual Basis Applied in Affirming the Rejection is Incorrect

Affirming the rejection of claims 11-15 and 27-30 under 35 U.S.C. § 103(a), the Board alleges that U.S. Patent App. Pub. No. 20023/0121401 to Ito (hereinafter, “Ito”) discloses wherein “each of musical instruments 10, 20, and 30 and mixer apparatus 40 can be implemented with apparatus like that depicted in Figure 3 (Id. at ¶ 0041), which includes, ... a mixing circuit 82....” (*emphasis in original*) See Decision at page 13. Thus, in order for the Board’s affirmation of the rejection of claims 11-15 and 27-30 to be correct, Ito must actually

teach wherein *each* of musical instruments 10, 20, and 30 and mixer apparatus 40 shown in FIGS. 1 and 2 of Ito include the mixing circuit 82 shown in FIG. 3 of Ito. For reasons discussed below, Ito does not, in fact, teach that which the Board alleges.

Specifically, paragraph 0041 of Ito reads:

Next, one embodiment of the electronic musical instruments used as the aforesaid music apparatus 10, 20 and a mixer apparatus of electronic musical instrument function incorporating type used as mixer apparatus 40 will be described with reference to FIG. 3.

This paragraph simply states that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40 of Ito, which are shown in FIGS. 1 and 2, will be described with respect to FIG. 3. The fact that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40 shown in FIGS. 1 and 2 can be described with respect to FIG. 3 does not mean that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40 shown in FIGS. 1 and 2 can be described with respect to FIG. 3 does not mean that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40, when taken individually, *must necessarily* include all of the components shown in FIG. 3 (including the mixing circuit 82). Indeed, upon reading paragraphs 0041-0052 of Ito, it is possible to conclude that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40, *only when taken collectively*, include all of the components shown in FIG. 3 (but when taken individually include only some of the components shown in FIG. 3).

For example, paragraph 0048 of Ito describes the relationship of musical instrument 10 shown in FIG. 2 and the apparatus shown in FIG. 3 by mapping all of the components of musical instrument 10 shown in FIG. 2 to only some of the components shown in FIG. 3. Nothing in paragraph 0048 of Ito, or in any other portion of Ito actually states that the musical instrument 10 shown in FIG. 2 includes the mixing circuit 82 shown in FIG. 3. Similarly, paragraph 0049 of Ito describes the relationship of musical instrument 20 shown in FIG. 2 and the apparatus shown in FIG. 3 by mapping all of the components of musical instrument 20 shown in FIG. 2 to only some of the components shown in FIG. 3. Nothing in paragraph 0049 of Ito, or in any other portion of Ito actually states that the musical instrument 20 shown in FIG. 2 includes the mixing circuit 82 shown in FIG. 3. Lastly, paragraph 0050 of Ito describes the relationship of mixer apparatus 40 shown in FIG. 2 and the apparatus shown in FIG. 3 by mapping all of the components of mixer apparatus 40 shown in FIG. 2 to only some of the components shown in FIG. 3, including the mixing circuit 82.

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DATE 10/10/2018

In view of the above, upon considering the teachings of Ito in their entirety, Appellant submits that only mixer apparatus 40 – *not* the electronic musical instruments 10, 20 and 30 – includes the mixing circuit 82 shown in FIG. 3. As such, Appellant submits Ito does not teach wherein *each* of musical instruments 10, 20, and 30 shown in FIGS. 1 and 2 actually includes the mixing circuit 82 shown in FIG. 3. Because Ito does not teach wherein *each* of musical instruments 10, 20, and 30 shown in FIGS. 1 and 2 actually includes the mixing circuit 82 shown in FIG. 3, the Boards affirmation of the rejection of claims 11-15 and 27-30 should be withdrawn.

The Legal Basis Applied in Affirming the Rejection is Incorrect

Remand Requested

As discussed above, the Board relied upon a factually incorrect interpretation of the teachings surrounding FIG. 3 of Ito to affirm the rejection of claims 11-15 and 27-30. The Board acknowledges that this interpretation is different from the interpretation presented by the examiner during prosecution. *See, e.g., Decision* at pages 11-12. The fact that the interpretation given to Ito in the Decision is different from that presented by the examiner during rejection means that the grounds for affirming the rejection of claims 11-15 and 27-30 is “new.” *See, e.g., MPEP 707.07(f), Form Paragraph 7.38.02, note 4, instructing the examiner to “insert the new ground(s) of rejection, e.g., different interpretation of the previously applied reference, newly found prior art reference(s), and provide an explanation of the rejection.” (emphasis added)*

CONCLUSION

Appellant requests that the rejection of claims 11-15 and 27-30 be reversed.

Customer No. 32231

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